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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,261	09/26/2001	Shinichi Morimoto	P/1929-85	8415

7590 04/13/2007	EXAMINER
Steven I. Weisburd, Esq. Dickstein Shapiro Morin & Oshinsky LLP 1177 Avenue of the Americas 41st Floor New York, NY 10036-2714	SIMITOSKI, MICHAEL J

ART UNIT	PAPER NUMBER
2134	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	09/963,261	MORIMOTO, SHINICHI
	Examiner	Art Unit	
	Michael J. Simitoski	2134	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _08 February 2007_.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-10_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-10_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _26 September 2001_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All   b) ☐ Some *   c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   The response of 2/8/07 was received and considered.

2.   Claims 1-10 are pending.

Response to Arguments

3.   Applicant's arguments filed 2/8/07 have been fully considered but they are not

persuasive.

4.   Applicant's response (p. 8) argues that the invention disclosed has no need to broadcast

authentication request information and there is no description that the base station broadcasts the

authentication request information and, using this rational, asserts that this limitation is

supported. However, because the specification discloses an example or embodiment where there

happens to be no disclosure of the base station broadcasting authentication request information

does not mean that the specification provides written description that explicitly not broadcasting

authentication request information from the base station is or was a feature of the invention, such

that the invention has novelty or non-obviousness based on its base station not broadcasting

authentication request information.

5.   Applicant's response (p. 9, ¶2) argues that it is necessary to Cropper's invention to

broadcast an authentication request under the standard of roaming. However, no factual

evidence of this assertion of inherency is given. Applicant is reminded that attorney arguments

are not considered evidence unless the arguments are an admission (MPEP §2145). Further,

6.   Applicant's response (p. 9, starting at ¶4) argues the following:

> *"The assertion that the authentication request information of claim 1 corresponds to the
> new user of Jones, and the reception packet of claim 1 corresponds to the new user of*

>*Jones is incorrect. In addition, RADIUS, which is regarded as corresponding to the*
>*authentication managing portion of claim 1, performs authentication for accessing the*
>*access Network operator registration server 36, and does not perform authentication for*
>*using the managed IP network."*

It is noted that Applicant gives no factual basis in support of this argument. However, as

the registration server exists on a protected IP network (managed IP network), it is maintained

that this portion teaches performing authentication for using the managed IP network (if only a

portion of the network, Fig. 1, #34).

7.   Applicant's response (p. 9) argues the following:

>*"Further, the assertion that "transferring the packet received from the interface portion*
>*to the LAN" of claim 1 corresponds to "transferring the packet to the managed IP*
>*network" is also incorrect. This assertion is incorrect, because the access operator*
>*RADIUS authentication server 34 does not transfer packet to the managed IP network to*
>*anywhere."*

However, Jones teaches transferring a packet to the managed IP network (to a LAN, col.

3, lines 20-37 & Fig. 1, ##34, 30, 31 & 32) when authenticating. It is clear that the packet is sent

through the tunnel seen in Fig. 1, #32.

8.   Applicant's response (p. 10, ¶1) argues the following:

>*"Further, the assertion that "transmitting to the packet received from the interface*
>*portion to the predetermined server or network-connected device" of claim 1 corresponds*
>*to "transmitting the packet to the Access Operators registration server 36 in incorrect.*
>*This assertion is wrong because the packet is transferred between the server 36 and the*
>*PC 22 not via the server 34. Those skilled in the art would not find the two destinations of*
>*the packet received by the server (server 34) of claim 1 in Jones."*

This is because, as col. 3, lines 11-15 discloses, the user is allowed access to the LAN if

already registered. However, if the user is not registered, the user request is to a predetermined

server or network-connected device (Access operators registration server, col. 3, lines 27-28).

This allows a non-authenticated user can still gain access to the registration server (col. 3, lines
33-35).

Claim Rejections - 35 USC § 112

9.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

10.   Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the written description requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed

invention. The specification does not describe wherein the base station does not broadcast the

authentication request information.

Claim Rejections - 35 USC § 102

11.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

12.   Claims 1-2 & 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent

5,819,178 to **Cropper**.

Regarding claims 1 & 5, Cropper discloses a base station (MSC,HLR,VLR,ISR, Fig. 4,

#113,121,130 [home]) comprising an interface portion (Fig. 6, #112) for making a

communication with a terminal station/MS (Fig. 6, #500) and extracting authentication request

information (call request) and a reception (registration) packet therefrom (col. 4, lines 35-65), a

first authentication managing portion (HLR) for determining whether or not to authenticate said

terminal station for said LAN (Visited network, Fig. 6, #100) corresponding to said

authentication request information/call request received from said interface portion (Fig. 3A &

col. 4, lines 35-57) and setting a result of the determination (Fig. 3C) to a first packet distributing

table (HLR/ISR, Fig. 6, #130) and a first packet distributing portion (HLR/ISR, Fig. 6, #130) for

referencing registered contents of said first packet distributing table (HLR/ISR, Fig. 6, #130 &

col. 6, lines 36-38) for the packet received from said interface portion (col. 5, lines 12-18),

transferring the packet received from said interface portion to said LAN (Visited network, Fig. 6,

#100 & col. 6, lines 47-52) when said contents of said first packet distributing table represent

that said terminal station has been authenticated for said LAN (HLR or VLR authenticates MS

previously, completed registration, Fig. 3A), and transmitting the packet received from said

interface portion to said predetermined server or network-connected device (VLR, Fig. 6, #430

& col. 5, lines 35-41) when said contents of said first packet distributing table represent that said

terminal station has not been authenticated for said LAN (Fig. 3B, process A, col. 5, lines 19-23

& lines 35-40), wherein the base station does not broadcast the authentication request

information (col. 6, lines 47-52).

Regarding claim 2 & 6, Cropper discloses a second authentication managing portion (ISR,

Fig. 6, #130), a second packet distributing portion (ISR, Fig. 6, #130) and a second packet

distributing table (ISR, Fig. 6, #130) for storing a plurality of destinations (addresses), wherein

said second authentication managing portion (ISR) is configured for determining whether or not

to authenticate said terminal station (MS, Fig. 6, #500 & col. 5, lines 19-23) corresponding to

said authentication request information and setting a result of the concerned determination to

said second packet distributing portion (ISR, col. 5, lines 19-23, Fig. 3C, process C & Fig. 6,

#130) when the result of the determination of said first authentication managing portion

represents that said terminal station has not been authenticated for said LAN (Visited network,

Fig. 6, #100), wherein said first packet distributing portion (VLR, Fig. 6, #130) is configured for

transferring the packet received from said terminal station/MS (Fig. 6, #500) to said second

packet distributing portion (ISR, col. 5, lines 12-23 & Fig. 6, #130) when said registered

contents/subscriber data of said first packet distributing table (VLR, Fig. 6, #130) represent that

said terminal station has not been authenticated for said LAN (Visited network, Fig. 6, #100),

and wherein said second packet distributing portion/ISR (Fig. 6, #130) is configured for

referencing the registered contents of said second packet distributing table (ISR, Fig. 6, #130) for

the packet received from said first packet distributing portion (VLR, col. 5, lines 12-23 & Fig. 6,

#130) and transmitting the packet received from said terminal station to an appropriate server or

network-connected device (Home HLR, Fig. 6, #430) corresponding to a destination (address) to

which the packet is distributed (col. 5, lines 19-23 & lines 35-40).

Claim Rejections - 35 USC § 103

13.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
manner in which the invention was made.

14.   10.   Claims 1, 3, 5 & 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over

U.S. Patent 6,873,609 to Jones et al. (**Jones**) in view of "Router Plugins: A Software

Architecture for Next Generation Routers" by Decasper et al. (**Decasper**). Jones discloses a base

station (access operator RADIUS authentication server, col. 3, lines 20-37) including an interface

portion for making a communication with a terminal station (PC) and extracting authentication

request information (new user request) and a reception packet (new user) therefrom (col. 3, lines

20-37), a first authentication managing portion (RADIUS) for determining whether or not to

authenticate said terminal station for a LAN (managed IP network, Fig. 1, #31) corresponding to

said authentication request information received from said interface portion, transferring the

packet received from said interface portion (to said LAN (managed IP, col. 3, lines 20-37) when

said terminal station has been authenticated for said LAN, and transmitting the packet received

from said interface portion to said predetermined server or network-connected device/Access

Operators registration server (col. 3, lines 20-37) when said terminal station has not been

authenticated for said LAN (col. 3, lines 20-37), wherein said base station/access operator

RADIUS authentication server does not broadcast the authentication request information. Jones

lacks setting a result of the determination to a first packet distributing table and a first packet

distributing portion for referencing registered contents of said first packet distributing table for

the packet received from said interface portion and consulting the first packet distributing table

for terminal authentication. However, Decasper teaches that high performance is achieved in a

network decision device by storing the result of a determination in a cache and consulting the

cache for result rather than the re-examining/authenticating (§3, 6 & P. 5, 2). By doing so, rather

than authenticating each of Jones's packets, if the determination that the packet has been

authenticated or denied authentication by the registration server, the cache is updated with the

resulted and consulted. Therefore, it would have been obvious to one having ordinary skill in the

art at the time the invention was made to set a result of the determination to a first packet

distributing table (cache) and to include a first packet distributing portion for referencing

registered contents of said first packet distributing table (cache) for the packet (new user)

received from said interface portion and consulting the first packet distributing table/cache for

terminal authentication. One of ordinary skill in the art would have been motivated to perform

such a modification to achieve high performance, as taught by Decasper (§3, 6 & P. 5, 2).

15.   Claims 3-4 & 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Cropper, as applied to claims 1-2 & 5-7 above, in further view of U.S. Patent 6,397,056 to

Bugnon et al. (**Bugnon**). Cropper lacks issuing an authentication request to an inner LAN

authentication server and setting a response to the authentication request in the packet

distribution table. However, Bugnon teaches that in order to reduce fraud in radio

telecommunications networks, networks include an authentication center, which is normally co-

located with the HLR (col. 1, lines 27-30). Each subscriber has an authentication key, which is

used to authenticate the mobile terminal (col. 1, lines 31-45, col. 2, lines 47-64 & Fig. 5).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the

invention was made to modify Cropper to issue an authentication request to an inner LAN

authentication server and setting a response to the authentication request in the packet

distribution table, instead of using plaintext identifiers. One of ordinary skill in the art would have been motivated to perform such a modification to reduce fraud in radio telecommunications networks, as taught by Bugnon (col. 1, lines 31-45, col. 2, lines 47-64 & Fig. 5).

16.   Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cropper**, as applied to claim 1 above, in view of U.S. Patent 6,606,491 to **Peck**. Claims 9-10 are substantially equivalent to, for example, claims 1-2. In this regard, Cropper discloses a system, as described above, but lacks explicitly registering a refusal in the packet distributing table if the terminal station has not been authenticated. However, Peck teaches that in mobile telecommunications systems, it is known to check a blacklist of mobile numbers when authenticating to deny access not only if the terminal is not authenticated, but also if the terminal is a stolen terminal (col. 1, lines 36-46, lines 50-54, lines 58-65, col. 5, lines 4-7 & col. 8, lines 15-17). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cropper to explicitly register an authentication refusal/blacklisted mobile terminal in the packet distributing table. One of ordinary skill in the art would have been motivated to perform such a modification to deny access if the terminal is a stolen terminal, as taught by Peck (col. 1, lines 36-46, lines 50-54, lines 58-65, col. 5, lines 4-7 & col. 8, lines 15-17).

Conclusion

17.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841.

The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJS

April 2, 2007

David Y. Jung
Primary Examiner

4/11/07